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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/817,330 | 03/26/2001 | Phillip C. Celaya | ONS00149 | 8912 |

7590 02/18/2004

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Patent Administration Dept - MD A230
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EXAMINER

PHAN, THIEM D

| ART UNIT | PAPER NUMBER |
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3729

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/817,330

Applicant(s)

CELAYA ET AL.

Examiner

Tim Phan

Art Unit

3729

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 19-37.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____




CARL J. ARBES
PRIMARY EXAMINER

Continuation of 5:

Applicants' remarks filed on January 28th 2004 re-traversing Claims 19-37 are hold not to be persuasive.

The Patent Office's position, as stated in the preceding Action, was and continues to be that since least Kim (US 6,162,664) hereinafter '664 teaches a method of making chip component, which reads on all Applicants' claimed invention.

With respect to Applicants' remarks about lead free: "... a solder layer 50 of Sn-Pb (see col. 4, lines 13-37 and FIG. 5 of '664." (Cf. Remarks, page 5, paragraph 4, lines 5 & 6) and " ... none of the leads 30 of '664 are lead (Pb)-free ..." (Cf. Remarks, page 5, paragraph 4, lines 6 & 7), the '664 teaches that both layers 60 and 50 have some trace of lead (Cf. Col. 4, lines 32-34) from the same Sn-Pb alloy only if the layer 60 is selected to be one choice of Sn-Pb alloy (Cf. Col. 4, lines 19 & 20). It is inherently obvious that, if the layer 60 is selected to be other choice of Ni-Au (Cf. Col. 4, lines 19 & 20), both layers 60 and 50 should also be of same Ni-Au, thus having no trace of lead as the same material or Ni-Au alloy on both layers 60 & 50 facilitates the cohesive printing of layer 50 over layer 60 (Cf. Col. 5, lines 15-27) and increases the bonding force of layer 50 (Cf. Col. 4, lines 21 & 22).

With respect to Applicants' claims about lead free: "... surface of a substrate to form a lead-free (first) lead ..." (Cf. Claim 1, lines 3 & 4; Claim 32, line 6), the '644 teaches such a lead free material as Ni-Au alloy (Cf. Fig. 5, elements 60 & 50; Col. 4, lines 19 ff.). It appears that Applicants fail to recognize the scope of the claims when judged in view of the '664. (Cf. In re Geuns, 26 USPQ 2nd 1057 (Fed. Cir. 1993)).

Subsequent dependent claims continue to be rejected as stated in Paper No. 13 (September 29th 2003).

Furthermore, the Patent Office saith not.

TM

Cja
CARL J. ARBES
PATENT EXAMINER